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IN THE

# Supreme Court of the United States

OCTOBER TERM 1949

No. 672

THE HYGIENIC PRODUCTS COMPANY,
*Petitioner,*

*vs.*

JUDSON DUNAWAY CORPORATION,
*Respondent.*

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

## BRIEF FOR RESPONDENT IN OPPOSITION

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### Opinions Below

The opinion of the District Court was reported in 81 Fed. Supp. 935 and may be found at pages 216 to 234 of the Record. The opinion of the Court of Appeals for the First Circuit was reported in 178 Fed. (2d) 461 and may be found at pages 285 to 293 of the record.

### Jurisdiction

The jurisdiction of this Court to issue the writ of certiorari applied for is predicated upon United States Code Title 28 Section 1254.

## Statement of Case

Believing that petitioner's statement of the facts is insufficient to afford a complete understanding of the questions presented by the petition, respondent submits the following statement of all the facts which respondent believes to be material to the petition.

Petitioner has been engaged, since 1911, in the manufacture and sale throughout the United States of a toilet bowl cleaner containing bisulphate of soda, sodium chloride and powdered soapstone. This product was covered by two patents which petitioner obtained in 1912 and 1915 respectively (Exhs. H-1, R. 74, 257-9 and H-2, R. 75, 260-3). The second of these patents did not expire until 1932 and it was only after that date that anyone could bring out a similar competitive product without risk of patent infringement.

Petitioner adopted the term SANI-FLUSH as the trademark for its product about 1911 and has since used that designation. Its product is sold in cans which are predominantly yellow having three yellow panels bordered with blue and white lines. On the larger panel the trademark SANI-FLUSH is prominently displayed in red letters and this panel also carries the pictorial representation of a toilet bowl and a female figure standing beside the toilet bowl and holding in her hand a can of SANI-FLUSH from which material is falling into the toilet bowl.

Petitioner has asserted trade-mark rights in the pictorial representation in addition to its trade-mark rights in the designation SANI-FLUSH. It bases its cause of action solely upon its use of this pictorial representation.

From time to time petitioner has changed the style of this pictorial representation which it claims as its trademark and has secured a number of certificates of registration therefor from the United States Patent Office (Exhs. A-1 to A-7, R. 56, 57, 237-243). None of the pictorial representations shown in registrations Exhibits A-1 to A-5 (R. 56-7, 237-241) have been used by petitioner on its product since about 1938 (R. 123).

In its advertising petitioner has used display cards Exhibits I-1 and I-2 (R. 82), leaflets (Exhs. B-1 and B-2, R. 81, 244-247), and periodical advertisements (see respondent's Request for Admissions) which portray a female figure standing beside a toilet bowl holding a can in her hand from which material is falling into the toilet bowl. In this advertising material petitioner's trade-mark SANI-FLUSH is prominently displayed, and in a great deal of it the SANI-FLUSH can is reproduced.

In 1937 respondent developed and commenced the distribution of a product designed for two purposes, namely, as a toilet bowl cleaner and bathroom deodorant (R. 167). This product is poured into a toilet bowl where, in contact with water, it cleans and deodorizes by chemical action. It was first sold in an oval black and white can on which respondent's trade-mark VANISH prominently appeared in white letters together with the representation of a toilet bowl and a stream of material falling from the word VANISH into the toilet bowl (Exh. 4, R. 133).

In 1942 the style of can was changed to a taller cylindrical shape printed in blue and white but still displaying prominently the trade-mark VANISH and the representation of a toilet bowl and the stream of material falling from the word VANISH into the toilet bowl, as above described. This can, which has been used ever since, is exemplified by Exhibit L (R. 94).

Beginning in 1937 respondent advertised its product by means of leaflets, folders, display cards, window streamers, and the like, which show a can of VANISH suspended above a toilet bowl with material falling from the can into the toilet bowl (Exh. 10, R. 175, 270, 271, and Exh. 11, R. 175), and one of which (Exh. 9, R. 173) shows, against a bathroom background, a woman holding a can of VANISH from which material is falling toward a toilet bowl which is not shown in full but clearly indicated by a raised seat cover. No complaint was ever made with respect to any of this advertising (R. 137) and it is not now complained of (R. 169) even though petitioner was fully informed of respondent's activities in this connection (R. 132).

In June 1946 respondent commenced to use a display card (Exh. K, 93, 170) which shows a bathroom background including tiled walls, lavatory, shower, shower curtains, and toilet bowl, and a woman holding a can of VANISH over the toilet bowl with material falling from the can into the toilet bowl.

In December 1946 respondent commenced distribution of leaflets advertising the product VANISH (Exh. C, R. 58, 248, 249), and bearing a picture of a bathroom with tiled walls, bath tub, shower curtains and toilet bowl, and a woman holding a can of VANISH over the toilet bowl with material falling from the can into the toilet bowl.

During March and April 1947 respondent caused to be published in a number of newspapers an advertisement of its product VANISH (Exh. E, R. 58, 253) illustrated with the pictorial representation of a woman holding a can of VANISH over a toilet bowl with material falling from the can into the toilet bowl. At about the same time it caused another advertisement (Exh. E-1, R. 61, 253) of its product VANISH to be published in newspapers, the advertisement being illustrated with the representation of a toilet bowl, a can of VANISH suspended over the toilet bowl with material falling from the can into the toilet bowl and a hand holding the can. In all the advertising material complained of the can clearly labelled VANISH is prominently depicted and in the colored material the characteristic blue and white color scheme of the VANISH can is reproduced.

The composition of this advertising material followed generally accepted and widely used principles of display advertising. The record establishes that this form of advertisement showing the product, the human form or a part thereof, and how to use the product or showing the product in use (R. 156) was widely employed in advertisements. Also that advertisements with persons in them are particularly effective in attracting attention; that advertisements with women in them attract more attention from women; that advertisements showing the product are particularly effective and desirable where so much

buying is done in self-service stores; and that advertisements showing a product in use are highly desirable (R. 162). It was also established on the basis of a survey of four magazines containing 1255 advertisements, that 96% were illustrated; that 88% showed the product or a package of it, in the illustration; that 75% showed the product or a package of it and a human figure or part thereof; and that 44% showed the product or a package of it and a human figure or part thereof in the act of using or showing how to use the product (R. 156).

There was no evidence that anyone had in fact been deceived by respondent's advertising or led to purchase respondent's product in the belief that petitioner's product was being supplied (R. 220).

On these facts the District Court held that respondent had infringed petitioner's trade-mark rights in the pictorial representation and had competed unfairly with petitioner. The Court of Appeals reversed and directed the entry of judgment for respondent.

## Argument

In opposing the grant of the petition respondent makes the following points:

1. The Court of Appeals correctly concluded that petitioner's alleged trade-mark rights do not constitute a proper basis for the broad monopoly claimed by petitioner of a commonly used type of advertising as applied to its own and to competitive products.

2. The Court of Appeals correctly applied the rule that the likelihood of consumer confusion is the proper test of infringement and unfair competition, and it was entirely proper for the Court of Appeals to do so because the contrary findings of the trial court were based entirely upon documentary evidence and physical exhibits which the Court of Appeals was as competent to consider as the trial court.

3. The questions presented by the petition are not such as to warrant consideration by this Court or the grant of the writ.

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(1) The essential facts in this case can be very concisely summarized. Each party manufactures a chemical powder which is dispensed in small cans and sold at retail to housewives, among others, for cleansing watercloset bowls. Petitioner calls its product SANI-FLUSH which it registered as its trade-mark and which appears prominently on its cans. Respondent calls its product VANISH which it registered as its trade-mark and which appears prominently on its cans. The cans of the respective parties differ in shape, size, color and labelling, the labels of petitioner's cans being predominantly yellow and those of respondent's predominantly blue, so that, as petitioner concedes, the dress of respondent's product is entirely dissimilar to that of petitioner's.

The only controversy in this case is about the use of a picture representing a housewife or maid holding a can of the powdered material and shown in the act of pouring the material from the can into a watercloset bowl. This picture petitioner places on its cans and uses in some of its advertising, thus showing its product in use and graphically describing the purpose for which and the manner in which its product is used. Respondent, in its advertising, but not on its cans, uses a similar picture to describe the purpose for which and the manner in which its product is used.

Despite the fact that petitioner's pictorial representation is clearly descriptive, petitioner asserts, but does not prove by competent evidence, that the primary purpose or function thereof is to indicate the source of its product and therefore that the picture constitutes a valid trade-mark and, for this reason, petitioner maintains that respondent should be perpetually enjoined from using a similar picture showing respondent's product in use and illustrating its utility and manner of application. Thus, the fundamental question at issue in this case is whether, by adopting and using, in connection with the sale of its product, a picture

descriptive of its utility and manner of application, petitioner thereby acquired a perpetual monopoly of the use of that or any similar picture in advertising such products, on the theory that the picture constitutes a valid trade-mark and therefore may be exclusively appropriated by petitioner alone.

In approaching the answer to this question, the Court of Appeals stated two propositions upon which it based its decision. The first proposition, which quotes from a decision of this Court (*Canal Co.* v. *Clark*, U. S. Sup. Ct. 1872, 80 U. S. 311, 324) is that

> "a mere representation of a can with powdered material flowing from it into a watercloset bowl could not constitute a valid trade-mark for the product here involved for one 'has no right to appropriate a sign or a symbol, which, from the nature of the fact that it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose' " (R. 289).

The second proposition stated by the Court of Appeals is that

> "A mere glance at the advertising section of almost any newspaper or periodical renders it unthinkable that any single manufacturer of such products as, for instance, women's underclothing, bathing suits or stockings, to mention only a few outstanding examples, can possibly be entitled to appropriate unto itself alone the exclusive right to advertise its products by representing them in use" (R. 291).

Based on these two propositions, the Court of Appeals refused to hold that whatever trade-mark rights petitioner had secured in its said picture were broad enough in scope to include respondent's picture, that is to say, broad enough to give petitioner a perpetual monopoly of using in advertising a similar picture which could easily be distinguished from its own picture. It matters little that the court reached its decision by holding that petitioner's picture

constituted a valid trade-mark of limited scope, as it did, rather than holding that the descriptiveness of the picture precluded petitioner from acquiring any valid trade-mark in it at all.

(2) The Court of Appeals correctly applied the rule that likelihood of consumer confusion is the proper test of infringement and unfair competition.

> "The only obligation resting upon Kellogg Company was to identify its own product lest it be mistaken for that of the plaintiff." (*Kellogg Company* v. *National Biscuit Company*, U. S. Sup. Ct. 1938, 305 U. S. 111, 119.)

> "A trade-mark only gives the right to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his. • • • When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth." (*Prestonettes* v. *Coty*, U. S. Sup. Ct. 1924, 264 U. S. 359, 368.)

> "• • • the legal test of trade-mark infringement is the same as the legal test of unfair competition, and basically that test is the likelihood of consumer confusion as to the source of the goods" (*Coca Cola Co.* v. *Snow Crest Beverages*, 1st C. C. A. 1947, 162 Fed. (2d) 280, 283. Certiorari denied 332 U. S. 809.)

Since the only evidence in the present case bearing on the issue of likelihood of consumer confusion, consists of documents and physical exhibits, it was entirely proper for the Court of Appeals to review this evidence.

> "A finding is 'clearly erroneous' when although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed." (*United States* v. *United States Gypsum Company*, U. S. Sup. Ct. 1948, 333 U. S. 364, 395.)

> "A finding of fact is clearly erroneous if it is against the clear weight of the evidence. It does not suffice

that it be supported by evidence. * * * In determining whether the finding was correct, we shall examine documentary evidence which we are as competent to consider as the trial court, * * *" (*Fleming* v. *Palmer*, 1st C. C. A. 1941, 123 Fed. (2d) 749, 751.)

"An incorrect conclusion by a trial court qualifies as a 'clearly erroneous' finding, for the correction whereof on appeal Rule 52 (a) specifically provides." (*Kuhn* v. *Princess Lida*, 3rd C. C. A. 1941, 119 Fed. (2d) 704, 706.)

If the Court of Appeals found the conclusion which the District Court drew from the documents and physical exhibits to be clearly erroneous, it was entirely proper for that court to set it aside and find that there was no likelihood of consumer confusion, which it did, as follows:

"Viewed as an entirety, for the commercial impression of an advertisement no less than a trade-mark is derived from it as a whole, not from its separate elements considered apart and in detail, it seems to us clear that these distinctive features of the defendant's advertising, in spite of its use therein of the feature it is entitled to employ, that is to say, an alluring young woman using its product, prevent the possibility of there being any genuine likelihood that purchasers of 'Vanish' would be so confused by the advertising of that product that they would think they were purchasing 'Sani-Flush' (R. 292).

* * * * *

"In conclusion it will suffice to say that defendant's advertising viewed as a whole by no means so closely resembles either the plaintiff's mark or its advertising, viewed also as a whole, as to warrant the conclusion that anyone seeing it would be likely to confuse the defendant's product with that of the plaintiff" (R. 293).

(3) The questions raised by the petition may be restated thus:

1. Are petitioner's alleged trade-mark rights to be strictly construed?

2. Has respondent infringed?

3. Has respondent competed unfairly?

4. Did the Court of Appeals give due regard to Rule 52 (a)?

None of these questions are such as to call for the granting of the petition under the criteria set forth in paragraph 3 (b) of Rule 38 of the rules of this Court. It does not appear, that there is any conflict of decisions in the same matter, or that an important unsettled question of Federal law is involved, or that any Federal question has been decided in conflict with applicable decisions of this Court. And certainly the reversal of the District Court by the Court of Appeals does not constitute such a departure from the usual course of judicial proceedings prescribed by Rule 52 (a) as to warrant the grant of the petition.

Essentially the questions presented by the petition relate solely to this particular case and can have no possible application to any other case.

A review of trade-mark and unfair competition cases in the Circuit Courts of Appeal which have been reported during the past five years, reveals that out of 43 petitions for certiorari which were filed in this Court, 40 were denied. Since this Court does not ordinarily grant certiorari merely to review findings in particular cases in order to determine whether they are correct and were properly made, the writ should not issue.

Respectfully submitted,

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